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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,641	12/05/2000	Ching-Chih (Jason) Han	CREO.009US0	9293

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EXAMINER	
FIELDS, COURTNEY D	
ART UNIT	PAPER NUMBER
2137	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/730,641	HAN ET AL.	
	Examiner	Art Unit	
	Courtney D. Fields	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 August 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16,18,21 and 23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16,18,21 and 23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1,3-5,7-16,18,21, and 23 have been amended.

2. Claims 17,19-20, 22, and 24-25 have been cancelled.

3. Claims 1-165,18,21, and 23 are pending.

Response to Arguments

1. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection, in view of Perlman (US Patent No. 5,901,227).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1,10,13,16, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (U.S. Patent No. 6,202,150) in view of Perlman (U.S. Patent No. 5,901,227)

As per claims 1,10,13,16, and 21, Young et al. teaches a method and apparatus for generating encrypted source code of a program, generating a software key to decrypt the encrypted source code, and providing the encrypted source code to a licensee in Column 6, lines 47-67, Column 2, lines 1-60. However, Young et al. does not specifically teach providing the software key to an escrow holder who is under

instructions to provide the software key to the licensee upon satisfaction of a release condition, wherein the software key is otherwise unavailable to the licensee at any time. Perlman teaches a method for key escrow implementation by notifying an encrypting principal (escrow holder) about escrow authorities requiring access to a secret key used to encrypt information in Column 5, lines 21-20. Perlman also teaches a method wherein the software key (public key) is provided to the escrow holder (principal) who is under escrow instructions to provide the key to the licensee only if the licensee meets the requirements based upon information stored within the licensee certificate in Figures 3 and 4, and Column 6, lines 1-50. The key is unavailable to the user at all times, unless the requirements based upon the escrow instructions are met by the licensee in Column 7, lines 30-51. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Young's teachings of auto-escrowable and auto-certifiable cryptosystem and Perlman's key escrow encryption method. This method will prevent the encrypted key from being available to the escrow holder (principal), by using escrowed encryption only the intended licensee can decrypt the encrypted information stored within a certificate. This will enhance secure transmission within a licensing string area, which is used to escrow an encryption key and designating the escrow holder to release the key only if the requirements are met (See Perlman, Column 1, lines 41-55 and Column 2, lines 8-24)

As per claim 2, (Young et al. as modified) discloses the claimed limitation wherein the software key is randomly generated while generating the encrypted source code in Column 7, lines 61-67, Column 8, lines 1-5.

As per claims 3, 8,11,14,18, and 23, (Young et al. as modified) discloses the claimed limitation wherein generating binary executable code of the program, and providing the encrypted source code, and the binary executable code of the program to the licensee in Column 8, lines 6-61.

As per claims 5,9, and 12, (Young et al. as modified) discloses the claimed limitation wherein the providing of the software key to the escrow holder includes transferring information of the software key along with an identification of the licensee to the escrow holder in Column 10, lines 34-58.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. and Perlman further in view of W. Richard Stevens (TCP/IP, Illustrated, Vol. 1).

As per claim 1, Young et al. and Perlman discloses the invention as claimed above. However, as per claim 4, Young et al. nor Perlman specifically disclose providing the source and binary codes over the Internet using file transfer protocol (FTP). As per claim 4, Stevens teaches FTP is commonly used to transfer files from one system to another. (See page 419) Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Steven's teachings of file transfer protocol (FTP) with Young's auto-escrowable and auto-certifiable cryptosystem and Perlman's key escrow encryption method. In order to gain the benefits of a protocol that works between different systems, by supporting a number of files types and file structures between the varied systems. (See Stevens, page 419)

4. Claims 6-7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. and Perlman further in view of Sudia (U.S. Patent No. 5,799,086). As per claims 1 and 13, Young et al. and Perlman discloses the invention as claimed above. However, as per claims 6-7 and 15 Young et al. nor Perlman specifically disclose providing the key to the escrow holder by email.

As per claims 6,7, and 15, Sudia discloses the claimed limitation wherein the providing of the software key to the escrow holder includes emailing the software key to the escrow holder in Column 40, lines 24-67, Column 41, lines 1-6. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Sudia's enhanced cryptographic system with a key escrow feature with Young's auto-escrowable and auto-certifiable cryptosystem and Perlman's key escrow encryption method. Sudia's teaching of a cryptographic system with a key escrow wherein a key is provided to the escrow holder (CA) via email during registration allows the trusted device to communicate with other trusted devices. (See Sudia, Abstract)

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Desmedt, Yvo, "Securing Traceability of Ciphertexts – Towards a Secure Software Key Escrow System" – discloses a method for tracing ciphertext communication between two users of a key escrow system.

Schell et al. (US Patent No. 6,701,433) discloses a method and apparatus for escrowing properties used for accessing executable modules.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Courtney D. Fields whose telephone number is 571-272-3871. The examiner can normally be reached on Mon - Thurs. 6:00 - 4:00 pm; off every Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cdf
October 28,2005

MATTHEW SMITHERS
PRIMARY EXAMINER
Art Unit 2137